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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,062	10/02/2000	Raymond W. Coles	ULTRA-1001	4462
26453	7590	11/03/2003	EXAMINER	
BAKER & MCKENZIE 805 THIRD AVENUE NEW YORK, NY 10022			FUREMAN, JARED	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/678,062	COLES, RAYMOND W.	
	Examiner	Art Unit	
	Jared J. Fureman	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9/29/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of the extension of time, RCE, amendment, and IDS, filed on 9/29/2003, which have been entered in the file. Please note that many of the references listed on the IDS have been lined through since they were previously cited on a PTO-892. Claims 1-20 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/2003 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale (US 5,990,918, previously cited) in view of Lyszczarz (US 4,897,533, previously cited).

Baxendale teaches a method of forming a security card/printed item (an identification card or bank/credit card, for example, see column 2 lines 17-19),

comprising the steps of: providing a substrate (4) having a first surface; thermally depositing identification details onto the first surface of the substrate (dots or pixels 6 formed of pigment 3, are transferred to the receiver layer 4 via the use of heater elements 5, see column 2 line 66 - column 3 line 7. Since the card is an identity/bank/credit card, the dots or pixels serve as identification details); depositing a protective layer (7) of plastics material onto the substrate so as to protect the identification details (6) and selectively altering the optical properties of the protective layer (in areas 7' or 10) so as to form a security image therein; wherein the layer of plastics material is provided on a carrier film (see column 3 lines 8-13) and in which a plurality of heater elements (5) are provided on a thermal print head (1), and in which the heater elements are energized when the carrier film is in contact with the substrate to transfer the plastics material to the substrate (see column 3 lines 8-23); wherein the heater elements are energized to deposit a continuous layer of the plastics material over the whole of the area to be covered such that the plastics material serves as a protective coating (see column 2 lines 4-6 and column 3 lines 8-17); wherein selected regions (7' or 10) of the plastics material are heated to a greater degree than other areas so as to vary the surface appearance of the plastics layer (see column 3 lines 13-27); wherein the full thickness of the plastics film is deposited and selected portions thereof are overheated so as to give these portions a different appearance (see column 2 lines 31-35 and column 3 lines 28-40); wherein the overheated portions have a satin appearance (see column 2 lines 31-35 and column 3 lines 28-40); wherein the overheated portions have a matte appearance (see column 2 lines 31-35 and column 3

lines 28-40); wherein the security image is printed over the substrate in a repeating pattern (as seen in figures 3 and 4, the regions 7' and 10 are formed in a repeating pattern); a surface printed in accordance with the method (the surface of the plastics material 7); wherein the layer of plastics material is deposited on the substrate during a printing process (the plastics material is deposited using printhead 1); wherein the item is an identity card, bank card, or credit card (see figures 1-4, column 1 line 10 - column 2 line 35, column 2 line 66 - column 3 line 40).

Baxendale fails to teach the substrate having a reflective region covering a portion of the substrate; altering the optical properties of the protective layer in at least a region overlying the reflective region; the reflective region comprising a metal film; wherein the metal film is printed onto the substrate; wherein the metal film is provided on a carrier film and is brought into contact with the substrate at a printing station and transferred to the substrate.

Lyszczarz teaches a method and an item comprising: providing a layer of plastics material (4) over a substrate (2), the substrate having a reflective region (3) covering a portion of the substrate; the reflective region comprising a metal film; wherein the metal film is printed onto the substrate (the heat transfer of the foil 3 can be considered printing), wherein the metal film is provided on a carrier film (see column 4 lines 44-48) and is brought into contact with the substrate at a printing station (not shown, see column 4 line 41 - column 5 line 8) and transferred to the substrate (see figure 1-3, 5, 6, column 1 lines 13-19, column 1 line 57 - column 2 line 20, column 2 line

53 - column 3 line 6, column 3 lines 31-56, column 4 lines 1-10, column 4 line 41 - column 5 line 16, and column 5 lines 29-43).

In view of Lyszczarz's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Baxendale, the substrate having a reflective region covering a portion of the substrate; altering the optical properties of the protective layer in at least a region overlying the reflective region; the reflective region comprising a metal film; wherein the metal film is printed onto the substrate; wherein the metal film is provided on a carrier film and is brought into contact with the substrate at a printing station and transferred to the substrate, in order to provide an attractive, distinctive appearance (see column 1 lines 12-24 and 43-51).

4. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale as modified by Lyszczarz as applied to claim 1 above, and further in view of Peyret (US 5,688,056, previously cited).

Baxendale as modified by Lyszczarz fails to specifically teach the security image to be formed in the plastics film being held in a memory device readable by the printer; wherein the memory device is a removable memory device; wherein the security image is held in an encrypted form.

Peyret teaches a system and method wherein a security image (security mark) to be printed is held in a memory device (cartridge 104) readable by a printer (102); wherein the memory device is a removable memory device; wherein the security image

is held in an encrypted form (see figures 1, 2, column 3 lines 53-60, column 4 lines 15-21, 40-43, column 5 lines 16-33).

In view of Peyret's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Baxendale as modified by Lyszczarz, the security image to be formed in the plastics film being held in a memory device readable by the printer; wherein the memory device is a removable memory device; wherein the image is held in an encrypted form, in order to provide greater security, thereby helping prevent fraudulent printing of the image.

Response to Arguments

5. Applicant's arguments filed 9/29/2003 have been fully considered but they are not persuasive.

In response to applicant's argument that only a portion of the substrate has a reflective region, Lyszczarz teaches away from this limitation (see pages 6-7 of the amendment filed on 9/29/2003), while Lyszczarz teaches the reflective element 3 covers the entire front of the substrate 2 (see figure 3 of Lyszczarz), this still meets applicant's claimed limitation. While the claims recite that a reflective region covers "a portion" of the substrate, there is nothing in the claims that precludes the reflective region from covering the entire substrate. A reflective region that covers the entire substrate also, by necessity, covers "a portion" of the substrate. Thus, the teachings of Lyszczarz meet the claimed limitation.

In response to applicant's argument that there is no suggestion to combine the references (see pages 6-7 of the amendment filed on 9/29/2003), the examiner

recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lyszczarz teaches that the purpose for providing a reflective region 3 is to provide a card with an attractive, distinctive appearance to identify and promote the company or other entity issuing the cards (see column 1 lines 12-24 and 43-51).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

October 30, 2003

Jared J. Fureman
Jared J. Fureman
Art Unit 2876